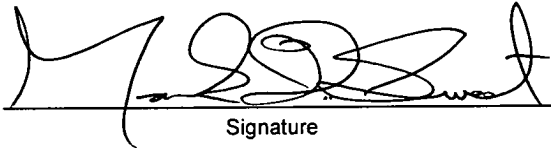


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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 05725.0922-00000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/023,330		Filed December 20, 2001
	First Named Inventor Isabelle ROLLAT		
	Art Unit 1617		Examiner G. YU
	<p>Applicant requests review of the rejections set forth in the final Office Action dated July 2, 2007, in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal and appropriate fees. Please charge any additional required fees to our Deposit Account No. 06 0916.</p> <p>The review is requested for the reasons stated on the attached five sheets. Note: No more than five (5) pages may be provided.</p>		
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,469</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>			
		<p> Signature</p> <p><u>Mark D. Sweet</u> Typed or printed name</p> <p><u>202-408-4162</u> Telephone number</p> <p><u>December 21, 2007</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In reply to the Office Action dated July 2, 2007, the period for response having been extended to January 2, 2008, by the petition for a three-month Extension of Time and fee submitted herewith, Applicants respectfully request panel review of the outstanding rejections under 35 U.S.C. § 103(a) identified in the Remarks below. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and completed form PTO/SB/33. No amendments are being filed with this Request.

REMARKS

In the Final Office Action dated July 2, 2007, the Examiner has maintained the rejection of claims 167, 168, 171, 172, 174, 175, 177, 178, 180, 181, 185-191, 193-203, 205-208, 210-216, 218-228, 230-240, 242-245, 247-253, 255-258, 260-266, 268-278, 280, 290, 292-302, 304-307, and 309-311 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,019,377 to Torgerson (hereafter, "*Torgerson*") in view of U.S. Patent No. 6,013,722 to Yang et al. (hereafter, "*Yang*") for the reasons disclosed on pages 2-7 of the Final Office Action. Applicants respectfully traverse this rejection for at least the reasons of record as well as the reasons presented below.

Consideration of the Prior Art as a Whole Teaches Away From Combination Suggested By The Examiner

The Examiner states that it would have been obvious to combine the prior art "by **substituting** the adhesive polymer [of *Torgerson*] with the adhesive copolymer comprising n-butyl acrylate/2-hydroxy ethyl (meth)acrylate/2-ethyl hexyl acrylate monomers [of *Yang*]." Final Office Action at 5 (emphasis added). This statement fails to take into account the teaching of *Torgerson* as a whole, as required by *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966).

Torgerson teaches the use in hair styling hold compositions of low glass transition temperature adhesive copolymers of the general chemical structure $(H_x)_m-(L_y)_n$ defined “wherein H is one or more monomer components having homopolymers with relatively high glass transition temperatures, with **at least one H monomer being selected from acrylate amides or methacrylate amides**; L is one or more monomer components having homopolymers with relatively low glass transition temperatures, with **at least one L component being selected from acrylate ester or methacrylate esters.**” *Torgerson* at col. 3, lines 25-34 (emphasis added).

Yang is directed to pressure-sensitive adhesive compositions comprising “(a) 50-90% by weight n-butyl acrylate, and (b) 10-50% by weight 2-hydroxy ethyl acrylate, or 2-hydroxy ethyl methacrylate, or hydroxypropyl acrylate monomer, or mixtures thereof.” *Yang* at col. 13, lines 61-65; see also col. 3, lines 13-18. Compositions according to *Yang* may optionally comprise additional copolymerizable monomers chosen from a list which includes, among numerous alternatives, 2-ethyl hexyl acrylate. *Id.* at col. 3, lines 18-45.

Thus, the Examiner’s allegation that it would have been obvious to substitute the adhesive polymer of *Torgerson* with the adhesive copolymer of *Yang* fails to take into account the scope and content of *Torgerson* as a whole. *Torgerson* requires the presence of the (meth)acrylate amides in its polymer, and no such monomers are disclosed in *Yang*.

In the Final Office Action, in response to Applicants’ observation that the combination proposed by the Examiner necessarily requires omission of the acrylate and methacrylate amides of *Torgerson*, the Examiner asserted that “there is teaching, suggestion, or motivation, either explicit or implicit, to exclude those polymers.” *Id.* at 7. Applicants disagree, and submit no such teaching exists. *Torgerson* specifically and repeatedly teaches that its copolymers **must** comprise “at least one H monomer component

being selected from acrylate amides or methacrylate amides.” *Torgerson* at col. 3, lines 28-30. Each and every adhesive copolymer according to the invention disclosed by *Torgerson* comprises at least one acrylate amide or methacrylate amide component, with the lowest disclosed amide content being 10 wt%. *Id.* at col. 5, line 5 - col. 6, line 10; *see also*, Examples I-XV. At no point in the entire disclosure of *Torgerson* is omission of the amides allowed for, let alone suggested.

Omission of acrylate amides and methacrylate amides would render copolymers according to *Torgerson* unsatisfactory for *Torgerson*’s intended purpose. M.P.E.P. § 2143.01.V, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984), instructs that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Accordingly, the combination proposed by the Examiner requires an impermissible modification of the prior art.

Yang Does Not Indicate Functional Equivalence Of n-Butyl Acrylate/2-Ethyl Hexyl Acrylate Copolymer And n-Butyl Acrylate/2-Hydroxy Ethyl (Meth)Acrylate Copolymers

In the Final Office Action, the Examiner asserts that “Yang teaches the similarity between n-butyl acrylate/2-ethyl hexyl acrylate copolymer and n-butyl acrylate/2-hydroxy ethyl (meth)acrylate copolymers” and that “[s]ince Yang teaches that 2-ethyl hexyl acrylate and 2-hydroxy ethyl (meth)acrylate are used for the same purposes, combining these monomers to make a copolymer for the known properties of would have been well within the skill in the art.” Final Office Action at 7. Applicants disagree.

As discussed above, all the adhesives of *Yang* comprise n-butyl acrylate and **either** 2-hydroxy ethyl acrylate, 2-hydroxy ethyl methacrylate, or hydroxy propyl acrylate. Optionally, adhesives according to *Yang* **may** also comprise, in addition to n-butyl acrylate

and at least one of 2-hydroxy ethyl acrylate, 2-hydroxy ethyl methacrylate, and hydroxy propyl acrylate, monomer units chosen from a list which includes, among numerous alternatives, 2-ethyl hexyl acrylate. However, even if these optional monomers are added to the adhesive, **either** 2-hydroxy ethyl acrylate, 2-hydroxy ethyl methacrylate, or hydroxy propyl acrylate **must still represent** at least 10% by weight of the resulting copolymer. Therefore, *Yang* does not teach any similarity between n-butyl acrylate/ethyl hexyl acrylate copolymers and n-butyl acrylate/2-hydroxy ethyl methacrylate copolymers because *Yang* simply does not allow for copolymers in which 2-ethyl hexyl acrylate monomers **substitute completely** for 2-hydroxy ethyl (meth)acrylate monomers.

In the absence of any indication of functional equivalency between n-butyl acrylate/2-ethyl hexyl acrylate and n-butyl acrylate/2-hydroxy ethyl (meth)acrylate copolymers, one of ordinary skill in the art would therefore have lacked the guidance necessary to pick and choose from *Yang*'s numerous disclosed monomers only those of relevance to the present invention.

Reshapable Effect Recited In Claims Not Taught Or Suggested By Prior Art

Finally, Applicants submit that one of ordinary skill in the art would have had no motivation or expectation for success in combining *Torgerson* and *Yang* to obtain a composition providing a reshapable hair styling effect, as presently claimed. Contrary to the Examiner's assertion that "[t]he recited reshapable effect of the composition of the combined references would have been immediately apparent to the skilled artisan who was combined the compositions as motivated by the references" (Final Office Action at p. 6), *Torgerson* and *Yang* are directed to adhesive compositions with distinctly different properties. *Torgerson* teaches that its adhesive compositions are useful "for providing **temporary set style hold**," defining such "temporary set" as "a temporary arrangement

which can be **removed by water** or by shampooing.” *Torgerson* at col. 2, lines 14-19, and col. 1, lines 29-31 (emphasis added). In contrast, *Yang* repeatedly emphasizes that its adhesive compositions are “water-resistant,” “water-insensitive,” and “resistant to the effects of high humidity.” See, e.g., *Yang* at col. 2, lines 58-60; col. 3, lines 1-6; col. 6, lines 58-64; Claims 1-11. Thus, one of ordinary skill could not have predicted the properties of a composition combining adhesives according to *Torgerson*, which wash away in water, and adhesives according to *Yang*, which are impervious to water.

Moreover, in response to Applicants’ previous argument that the prior art does not teach or suggest the claimed “reshapable effect,” the Examiner states that “[t]he rejection is not based on inherency.” Final Office Action at 6. This statement seems to be at odds with the Examiner’s previous statement that “[t]he recitation ‘reshapable’ denotes a physical property of the claimed composition.” *Id.* at 5. Turning again to the Examiner’s assertion that “[t]he recited reshaping effect of the composition of the combined references would have been immediately apparent to the skilled artisan” (*Id.*), Applicants respectfully disagree and submit that the Examiner has pointed to no reasoning that would support her conclusion. *Torgerson* and *Yang* are directed to adhesive compositions with divergent properties, and both are simply silent with respect to reshaping effect. “Obviousness cannot be predicated on what is not known at the time an invention is made.” M.P.E.P. § 2141.02(V).